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Re: **Application Serial No.:** 09/384,650
Confirmation No.: 8099
Appellants: James A. Michael, et al.
Title: Method For Dispensing Medical Items
Docket No.: D-1079 DIV

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated February 26, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 10-0637.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

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D-1079 DIV

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Reply
Brief
#19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

James A. Michael, et al.

Serial No.: 09/384,650

Confirm. No.: 8099

Filed: August 27, 1999

Title: Method For Dispensing
Medical Items

Art Unit 3653

Patent Examiner:
Michael E. Butler

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

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REPLY BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated February 26, 2003 is acknowledged.

Appellants respectfully submit that the Appeal Brief already addresses most of the issues mentioned in the Answer. Thus, please also note the Appeal Brief.

Initial Comments

The Appeal Brief was filed April 19, 2001. Appellants are pleased that the Examiner has finally written an Examiner's Answer.

Appellants acknowledge that the rejections of claims 40-44, 46-49, 52-60, 62-64, and 66-67 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Kraft have been vacated. That is, the Answer has removed Issue 7 (Appeal Brief page 7).

Appellants also acknowledge that the rejections of claims 40-49, 52-60, and 62-67 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Kraft in view of Pitel have been vacated. That is, the Answer has removed Issue 8 (Appeal Brief page 7).

Grouping of Claims

The Answer (at page 4), as best understood, alleges a "Groupings" of claims. The Answer states that "several dependent claims identically further limit their respective base claims and comprise common groupings." Appellants respectfully disagree. There are no identical

dependent claims. Appellants' Appeal Brief includes a proper statement that the claims do not stand or fall together. Separate arguments for the claims may be found in the Appeal Brief. Furthermore, Mr. Gerald Goldberg, Director of Technology Center 3600, in the decision dated March 18, 2002 in granting Appellants' petition, deemed that Appellants' Appeal Brief was appropriate under 37 CFR § 1.192.

The Art Rejection Table

The Table presented on pages 7-11 of the Answer is incomprehensible. It appears that the Office is attempting to insert new rejections into the Answer, which is impermissible. The Table does not correspond to the rejections from which the appeal was taken. For example, appealed claims 52-53 were not rejected as being anticipated by Blechle or Higham. Yet these rejections are in the Table. Also, Williams was previously only applied against appealed claims 63-67. However, the Table has Williams applied against claims 40, 49, 52, 53, 60, 62, and 64-67, yet not applied against claim 63. Also, Halverson was previously only applied against appealed claims 63-64, yet the Table shows Halverson applied against 40, 41-42, 44, 49, 52, 53-55, 60-62, 64-67, yet not applied against claim 63. Also, Pitel was not previously applied in any anticipation rejection, but the Table appears to indicate otherwise. There are many other factors resulting in further lack of clarity in the Table. Thus, Appellants respectfully submit that the Table should be disregarded. The Office's attempted use of an incomprehensible Table (and the implied insertion of new rejections) is reflective of all the baseless rejections from which the appeal was taken, as shown in more detail in the Appeal Brief.

Higham in view of Gardner '294

In the final rejection (dated December 4, 2000) from which the appeal was taken, claims 63 and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Gardner '294. These rejections are further respectfully traversed.

Appellants respectfully request that the rejections be withdrawn on the basis that the U.S. Patent 5,445,294 to Gardner was never of record until after Appellants' Appeal Brief was filed. Note Appellants' previous remarks (herein incorporated by reference) regarding the Gardner '294 reference in the Response filed August 30, 2002 and the Appeal Brief. The Office's improper application of the Gardner '294 reference is further reflective of all the baseless rejections from which the appeal was taken.

Appellants further respectfully submit that the Office's attempted reliance on Gardner for the subject matter regarding claims 63 and 65-67 is further evidence that Higham does not anticipate claims 63 and 66 (Issue 3; Appeal Brief page 6) nor render obvious claims 63 and 66-67 (Issue 6; Appeal Brief page 7).

Furthermore, the Office has not explained how Higham could have been modified with the Gardner '294 reference teaching to have produced the recited invention. The Answer (at paragraph number 10) admits that Higham does not disclose engaging a latching lever with a latching pin. However, Appellants respectfully submit that Higham also lacks additional features. For example, where does Higham teach or suggest engaging a dispenser module latching lever with an enclosure latching pin "to hold" a dispenser "module" in a first position (e.g., claim 65)? Appellants' disclosure provides basis for engaging a dispenser module latching

lever (36, 38) with an enclosure latching pin (44) to hold a dispenser module (28, 30) in a first position. Higham has a drawer lid (280) with an arm (288), and a release button (284) with a latch (290) (col. 28, lines 4-41; Figures 29-31). Gardner '294 cannot alleviate the admitted and previously discussed deficiencies of Higham as it does not disclose or suggest the recited features which are not found in Higham. Gardner '294 has fixed rods (91) which normally prevent drawer latches (82, 83) from opening (col. 7, lines 19-45). Neither Higham nor Gardner '294, taken alone or in combination, disclose or suggest the recited features and relationships.

Further, Gardner '294 relies on controlled solenoids (130-135) for rod movement (also admitted by the Office in the final rejection dated December 4, 2000 at paragraph number 17), whereas Higham relies on a simple release button (pushed by a finger). It would not have been obvious to one having ordinary skill in the art to have modified Higham with the solenoids of Gardner '294 to have produced the claimed invention. The alleged modification of Higham with the teaching of Gardner '294, if it were even somehow possible, would destroy the utility or advantage of the Higham teaching and would render the disclosed device of Higham inoperable. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). The Office does not factually support any *prima facie* conclusion of obviousness. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The Individual References

In the Answer at pages 20-24, the Examiner refers to individual references, and new additional descriptions and new applications thereof. The Answer indicates that these new descriptions and applications were "requested" by the Appellants. Appellants did previously request the Office to explain where the specific features recited in Applicants' claims were allegedly found in the applied art. However, Appellants' request was prior to the final rejection (dated December 4, 2000) from which the appeal was taken, not after the Appeal Brief was already filed. Nevertheless, Appellants are not surprised by the Office's attempt to first explain the rejections after the Appeal Brief has been filed. Again, the Office's tardy attempt at reference descriptions and their application is merely reflective of all the baseless rejections.

The Answer on page 23 references Williams '294. The body of the reference also refers to Kraft. However, there is no rejection based on Williams and Kraft. The body of the reference further alleges that a "Latching lever is not used in any method step." Appellants respectfully disagree. For example, claim 65 clearly recites "engaging the latching lever with the latching pin to hold the module in the first position."

The Answer on pages 23-24 references Gardner '294. On page 24 the Answer alleges that even though the unknown Gardner '294 was never made of record or provided to Appellants at the time of final rejection, because Gardner 5,940,306 was in Appellants' possession (along with Gardner 5,392,951) the Office did not have to reopen prosecution. The Office's reasoning is because Gardner 5,940,306 mentions Gardner 5,445,294 thereon. Appellants respectfully disagree, as discussed in more detail in their Response filed August 30, 2002. Again, the Office's

rationale regarding Gardner '294 is merely another example of the rationale used in all the baseless rejections.

The Examiner's many apologies are acknowledged. The Answer's removal of some of the many unnecessary cumulative rejections is further acknowledged.

Appeal Brief Sizes

The Examiner again returns to the issue of Appeal Brief sizes (Answer at pages 18-19). However, this issue was already decided in the Director's decision on petition (dated March 18, 2002), which agreed with Appellants that the Examiner was in clear error. The issue was a "petitionable matter." The Examiner cannot appeal the Director's decision to the Board of Patent Appeals and Interferences. That is, the Director's decision is not an "appealable matter" (on behalf of the Examiner).

The Examiner's comment regarding a "playing field" in the Answer at page 18, line 18 is unclear. Is the Examiner admitting that he is playing some type of game? If so, then perhaps this is the explanation for all the baseless rejections.

The Examiner's comment in the Answer at page 19, lines 3-6 is without merit. These comments are further reflective of all the baseless rejections in the Answer, as shown in more detail in the Appeal Brief. Appellants request that the Office strike said comment from the record, and that proof of such act be presented to Appellants. Contrarily, without Appellants' requirement to respond to each of the unnecessary cumulative rejections (which are in violation of MPEP § 706.02), the Appeal Brief size probably would have appeased the Examiner's self-created new rules.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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